

Applicants: Lutz Heuer et al.
Application No. 09/901,979
Amendment in Response to Office Action dated August 25, 2004

REMARKS

Applicants respectfully requests reconsideration and allowance of this application in view of the amendments above and the following comments.

Claims 9, 11, 12 and 15 are pending. Claim 12 is currently free of the prior art. Amendments have been made to claim 15 in response to the rejection under 35 U.S.C. 103. Changes that have been made to the claims using strikethrough and underlining are presented above. It is believed that no new matter has been added.

At the outset, Applicant wishes to address the showing required under 37 CFR §1.116(a) regarding why the amendments above are necessary and were not presented earlier. The amendments above were necessary to overcome the prior art rejection under 35 U.S.C. 103. Regarding the rejection under 35 U.S.C. 103, by amending claim 15 to cancel all of the subject matter with the exception of an azole selected from the group consisting of propiconazole and tebuconazole, Applicant believes the amendments should remove the prior art rejection. The amendments were not presented earlier because the amendments are responsive to a new ground of rejection made for the first time in the final rejection and since this is the first substantive response to the final rejection, obviously the amendments above could not have been presented earlier.

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Rejections under 35 U.S.C. 103

The Examiner rejected claims 9, 11 and 15 under 35 U.S.C. 103(a) as being obvious over Barnavon et al. (U.S. Patent No. 4,897,427). The Examiner found Barnavon teaches a composition comprising cyproconazole and the addition of a number of active ingredients to the composition. The Examiner conceded Barnavon does not explicitly show a composition comprising cyproconazole "plus propiconazole, prochloraz, hexaconazole, or flusilazole". Nevertheless, the Examiner found it would have been obvious to modify the composition in Barnavon to include propiconazole, prochloraz, hexaconazole, or flusilazole to yield the instantly claimed composition.

In response to the Examiner's rejection, Applicants point out that the thrust of the rejection is directly rebutted by the evidence already of record. MPEP §716.02(a) recites the following, in part:

"A greater than expected result is an evidentiary factor pertinent to the legal conclusion of obviousness ...of the claims at issue." *In re Corkill*, 711 F.2d 1496, 226 USPQ 1005 (Fed. Cir. 1985)...Evidence of a greater than expected result may also be shown by demonstrating an effect which is greater than the sum of each of the effects taken separately (i.e., demonstrating "synergism")

In the present case, the Declaration of Dr. Martin Kugler dated April 24, 2002, which is of the record and filed with Applicants' response on July 18, 2001, already shows that the combination of cyproconazole and propiconazole leads to a synergistic result, which synergistic result is completely unexpected in view of the cited prior art of record. An additive effect, as the Examiner's proposed combination would suggest, would have

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resulted in a value of X equal to 1. Clearly the data do not support this contention. "Test 1" at page 2 of the Declaration shows that when cyproconazole and propiconazole are combined, they achieve a synergistic effect as indicated by the value of 'X' equal to 0.67. Applicants submit this data directly rebuts the allegation that combining cyproconazole and propiconazole would have been obvious. Consequently, this rejection should be reconsidered and withdrawn on this basis alone.

Less there be any doubt that the improvement is realized with other combinations, Applicants point out that the data in the Declaration additionally supports the claimed *synergistic* effect between cyproconazole and a second ingredient other than cyproconazole. Thus the data shows similar benefits with other claimed combinations, wherein "Test 2" at page 3 shows a synergistic effect when cyproconazole and tebuconazole are combined, as indicated by the value of 'X' equal to 0.73. Thus, the data support a finding of unexpected and/or surprising results, whereby the claims as a whole are nonobvious by the combination of the cited references. See MPEP §716.02.

Applicants would also point out that the claims require the improvement which is demonstrated, i.e., that the combination of cyproconazole and the second ingredient is synergistic. Consequently, the claims are exactly commensurate in scope with the improvement.

Should the Examiner rely on a theory of inherency for the claimed combination and synergistic effect in view of Barnavon, Applicants would remind the Examiner of the

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following as pointed out by the Board of Patent Appeals and Interferences in *Ex parte* Levy, 17 USPQ2d 1461, 1463-1464 (BPAI 1990):

"[T]he initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention rests upon the Examiner. * * * In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. [Emphasis in original.]"

Moreover, MPEP §2112 recites: "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." Nowhere in Barnavon is there anything that would suggest a person skilled in the art that the claimed combination and resulting synergistic effect are inherent. Accordingly, Applicants submit claims 9, 11 and 15 are neither rendered obvious nor inherent by Barnavon.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Conclusion

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate

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allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

CONDITIONAL PETITION FOR EXTENSION OF TIME


If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,

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